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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,726	02/04/2004	Terry-Lee M. Fritz	200311549-1	5629

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EXAMINER

EVANISKO, LESLIE J

ART UNIT PAPER NUMBER

2854

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/772,726

Applicant(s)

FRITZ ET AL.

Examiner

Leslie J. Evanisko

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02-04-2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-14, 16, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Beck (GB 1 407 065). Beck teaches a method of marking an article comprising selecting a first light condition for view an article, printing first and second colored markings on the article, wherein the markings are metameretic and have the same color appearance under the first light condition.

With respect to claims 3-5 and 19-20, note Beck teaches a color printer including printing inks of metameretic pairs in which one of the inks may be a conventional ink or colour constant ink (i.e., process ink as defined in the specification) and the other ink is a metameretic ink (i.e., spot ink as defined in the specification)--see page 2, lines 70-75 and page 4, lines 1-15 of Beck in particular.

With respect to claim 6, Beck teaches printing the markings adjacent to each other in page 3, lines 56-62.

With respect to claim 7, Beck teaches choosing different light conditions (i.e., daylight vs. tungsten filament lamp) in lines 66-92 of page 3, for example and also teaches a plurality of metameric ink pairs can be used in lines 24-33 of page 4.

With respect to claims 9-11, note Beck teaches a fabric or paper article including metameric print markings as recited.

With respect to claims 12-13, note that claims 9-13 are considered to be product-by-process claims. As set forth in the MPEP, product by process claims are drawn to the product per se and how the product was made is of no patentable significance to these claims. Therefore, since a third marking on the product are capable of being made by either the same or a different printer that printed the first and second markings, Beck broadly meets the claim language as recited.

With respect to claim 14, Beck teaches an article comprising first and second markings that are metameric and have the same color under a first light condition and second and third markings that are metameric and have the same color appearance under a second light condition.

With respect to claim 16, note Beck teaches a paper article having first and second colored markings thereon that are metameric.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck (GB 1 407 065) in view of Hauser et al. (US 6,013,307). Beck teaches a method and article as recited with the possible exception of the light condition being copier light in particular. However, the use of copier light as the lighting condition with metamerics/security documents is well known in the art as exemplified by Hauser et al. In view of this teaching, it would have been obvious to one of ordinary skill in the art to use metamerics

inks with photocopier light as the lighting condition such that the first and second markings printed have either the same or different color appearance under copier lighting, to insure documents that are readily photocopied can not be passed off as original documents.

### ***Conclusion***


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DT 23 47 836 A1 teaches a process and product using metameric inks having obvious similarities to the claimed subject matter.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
October 8, 2004